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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIMON ALAN JONES
and PAUL JOSEPH MCARDLE

Appeal 2008-2261
Application 10/657,441¹
Technology Center 2600

Decided:² February 27, 2009

Before MAHSHID D. SAADAT, JOHN A. JEFFERY,
and MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Autodesk, Inc.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a non-final rejection of claims 1-21. As claims 5, 11, and 17 stand objected to as being dependent upon a rejected base claim (Non-final Rej. 6), and claims 6, 12, and 18 no longer stand rejected due to the withdrawal of rejections under §§ 101 and 112 (Ans. 2), only claims 1-4, 7-10, 13-16, and 19-21 are currently under appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter a new ground of rejection.

Appellants' invention relates to a computer aided design (CAD) application program that includes the ability for an object to automatically obtain data based on the object's location with respect to another object. A location property definition provides a mechanism for an object to obtain property values from property data on a polygonal object, area, or space near the object (para. 0012). In a preferred embodiment, a door object automatically obtains a door number from the number associated with the room in which the door is located (para. 0010).

Claim 1 is exemplary:

1. A method for specifying a location for an object in a drawing program comprising:

(a) obtaining a drawing having two or more existing objects in a drawing program;

(b) identifying one of the objects in the drawing program, wherein the identified object comprises a collection of one or more graphical elements;

(c) defining, without moving the identified object in the drawing, an automatic location property for the identified object, wherein;

(i) the automatic location property provides a location, within the drawing, for the identified object with respect to another object, area, or space; and

(ii) a value of a property of the identified object is obtained from property data of the other object, area, or space based on the location of the identified object; and

(d) displaying a representation of the automatic location property.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hollingsworth	US 5,444,836	Aug. 22, 1995
Matsushita	US 6,049,340	Apr. 11, 2000

Claims 1-3, 7-9, 13-15, and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hollingsworth.

Claims 4, 10, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hollingsworth in view of Matsushita.

Claims 5, 6, 11, 12, 17, and 18 are not currently subject to any rejection by the Examiner.³ As such, these claims are not the subject of this appeal.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Appeal Brief (filed July 23, 2007), the Reply Brief (filed November 8, 2007), and the Examiner's Answer (mailed October 9, 2007) for their respective details.

³ In the Examiner's Answer, the Examiner withdrew the non-final rejection of claims 1-21 under 35 U.S.C. § 101, and the non-final rejection of claims 7-12 and 20 under 35 U.S.C. § 112.

ISSUES

There are three principal issues in the appeal before us.

1. Did Appellants show that the Examiner erred in finding that Hollingsworth teaches obtaining a drawing having two or more existing objects in a drawing program?
2. Did Appellants show that the Examiner erred in finding that Hollingsworth teaches defining, without moving an identified object in the drawing, an automatic location property for the identified object, the automatic location property providing a location, within the drawing, for the identified object with respect to another object, area, or space?
3. Did Appellants show that the Examiner erred in finding that a value of a property of the identified object is obtained from property data of the other object, area, or space based on the location of the identified object?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellants, the invention relates to a computer aided design (CAD) application program that includes the ability for an object to automatically obtain data based on the object's location with respect to another object. A location property definition provides a mechanism for an object to obtain property values from property data on a polygonal object, area, or space near the object (para. 0012).

2. In a preferred embodiment, a door object automatically obtains a door number from the number associated with the room in which the door is located (para. 0010).

Hollingsworth

3. Hollingsworth teaches an automated placement subsystem for a CAD system, which permits a user to easily create and customize the rules governing the placement and interconnection of graphical objects on the graphical image being generated using the CAD system (col. 2, ll. 58-65).

4. Hollingsworth teaches determining a placement point for positioning a placeable object relative to the position of a previously placed placeable object (the reference object) (col. 12, ll. 4-6).

5. The offset of one object relative to another may be defined by properties DX, DY, and DTHETA. DX and DY refer to offset distances in the X and Y axis directions, respectively. DTHETA is a floating point value indicating the number of degrees to rotate the interim placement point (col. 12, ll. 9-28).

Matsushita

6. Matsushita teaches a CAD system which allows the user to establish various settings for the shapes and positions of objects (col. 2, ll. 10-12).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also* *KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one form of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

ANALYSIS

Claims 1-3, 7-9, 13-15, and 19-21

Claims 1, 7, and 13, the independent claims under appeal, all recite: (1) obtaining a drawing having two or more existing objects; (2) defining, without moving the identified object in the drawing, an automatic location property for the identified object, wherein the automatic location property provides a location, within the drawing, for the identified object with respect to another object, area, or space; and (3) that a value of a property of the identified object is obtained from property data of the other object, area, or space based on the location of the identified object. In rejecting these claims under 35 U.S.C. § 103, the Examiner asserts that Hollingsworth teaches all of these limitations (Ans. 3-4). We will address them in turn.

“Obtaining a drawing having two or more existing objects”

Hollingsworth is directed to creating user defined rules for the placement of graphical objects in a CAD application, and once those rules are defined, applying them to the creation of a new drawing that conforms to the rules (*see* Fig. 7; col. 2, l. 57 – col. 3, l. 4; col. 26, l. 59 – col. 28, l. 39). The Examiner, responding to Appellants’ arguments, states that in Hollingsworth “the drawing is obtained from the computer program *per se*, meaning, retrieving the data from the computer program,” and that Appellants’ arguments directed to the concept of “opening a previously user-

created drawing” are directed to an aspect of the invention not recited in the claims (Ans. 9).

The Examiner’s response, however, argues only that Hollingsworth teaches “obtaining a drawing” and never addresses the further limitation “*having two or more existing objects.*” By definition, Hollingsworth’s construction of a new drawing from a list of elements and a user-defined set of rules is not a process that begins with a drawing having two or more existing objects. We therefore find that Hollingsworth does not teach obtaining a drawing having two or more existing objects, as claimed.

“Defining an automatic location property”

Hollingsworth teaches determining a placement point for positioning a placeable object relative to the position of a previously placed placeable object (the reference object) (FF 4). The offset of one object relative to another may be defined by DX, DY, and DTHETA. DX and DY refer to offset distances in the X and Y axis directions, respectively. DTHETA is a floating point value indicating the number of degrees to rotate the interim placement point (FF 5).

The offset properties taught by Hollingsworth thus meet the claim limitation of providing a location within a drawing for an object to be placed relative to, i.e. *with respect to*, another object.

“Value of a property is obtained from property data of another object based on the location of the identified object”

The Examiner argues that Hollingsworth teaches this limitation, because Hollingsworth teaches the use of offset coordinates relative to the placement of a related graphical object (Ans. 8).

We are not persuaded that the Examiner's construction of the claim language is correct. Because Appellants use the term "property" in this clause, as contrasted with the phrase "location property" in the previous clause, and because the "property" is "based on the location of the identified object," we construe "property data of the other object" to mean something *other* than its location. Further, if "property" here *could* mean "location," this limitation would be superfluous to the previous limitation regarding the "automatic location property."

As a result of our interpretation of "property data of the other object," we have reviewed Hollingsworth for a teaching that a value of a property of the identified object is obtained from *non-location* property data of another object. We agree with Appellants (*see* App. Br. 13-14) that Hollingsworth contains no such teaching.

Summary

Because Hollingsworth does not teach obtaining a drawing having two or more existing objects, nor that a value of a property of the identified object is obtained from property data of another object, area, or space, we find that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 1, 7, and 13, as well as claims 2, 3, 8, 9, 14, 15, and 19-21 dependent therefrom. We therefore find error in the Examiner's rejection of claims 1-3, 7-9, 13-15, and 19-21 under U.S.C. § 103.

Claims 4, 10, and 16

Each of these claims depends from one of independent claims 1, 7, and 13, whose rejection we found to be erroneous *supra*. We therefore find

error in the Examiner's rejection of claims 4, 10, and 16, for the same reasons expressed with respect to parent claims 1, 7, and 13.

Rejection of claims 13-18 and 21 under 37 C.F.R. § 41.50(b)

We enter the following new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Claims 13-18 and 21 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 13 recites “[a]n article of manufacture comprising a program storage medium readable by a computer.” Appellants’ Specification discloses that “graphics program 108 comprises logic and/or data embodied in or readable from a device, media, carrier, or signal” (para. 0023). Reading independent claim 13 in light of the Specification, the recited article of manufacture encompasses a signal that performs the recited operations. Signals are not patentable subject matter under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007), *reh’g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008) and *cert. denied*, 129 S. Ct. 70. Therefore, when read in light of the Specification, independent claim 13 includes both statutory subject matter (computer-readable instructions stored on a tangible medium, e.g., a CD-ROM) and non-statutory subject matter (computer-readable instructions conveyed by a signal). According to USPTO guidelines, such claims must be amended to recite solely statutory subject matter.

Claims 14-18 and 21 depend from claim 13 and do not limit the recited program storage medium to statutory subject matter or to computer-executable instructions embodied on a tangible medium.

For the foregoing reasons, independent claim 13 and dependent claims 14-18 and 21 do not recite statutory subject matter under 35 U.S.C. § 101.

CONCLUSIONS OF LAW

Appellants have shown that the Examiner erred in finding that Hollingsworth teaches obtaining a drawing having two or more existing objects in a drawing program.

Appellants have not shown that the Examiner erred in finding that Hollingsworth teaches defining, without moving an identified object in the drawing, an automatic location property for the identified object, the automatic location property providing a location, within the drawing, for the identified object with respect to another object, area, or space.

Appellants have shown that the Examiner erred in finding that a value of a property of the identified object is obtained from property data of the other object, area, or space based on the location of the identified object.

ORDER

The Examiner's rejection of claims 1-4, 7-10, 13-16, and 19-21 is reversed.

We have also entered a new ground of rejection against claims 13-18 and 21 under 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that, "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or

both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

KIS

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